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EXAMINER

KASENGE, CHARLES R

ART UNIT

PAPER NUMBER

2121

MAIL DATE

DELIVERY MODE

03/31/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/575,532

**Applicant(s)**

BLUMBERG ET AL.

**Examiner**

CHARLES R. KASENGE

**Art Unit**

2121

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 34-41 and 44-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 34-41 and 44-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S508)
- Paper No(s)/Mail Date 1/10/07 4/12/06
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Double Patenting*

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 34-41 and 44-50 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 34-41 and 44-50 of copending Application No. 11/483,275.

This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

### *Specification*

3. The disclosure is objected to because of the following informalities: pg. 23 of the specification appears to be more appropriate as a Figure in the drawings.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 38-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. Regarding claims 38-40, the phrase "preferably" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).
7. Claim 39 recites the limitation "the workpiece flank" in line 5. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 34-41 and 45-47 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 34-41 recite a data carrier or electronic carrier signal. An electronic signal is non-statutory subject matter. Claims 45 claims a computer program with is non-statutory subject matter. Claim 46 claims a computer program product. A computer program is non-statutory subject matter. Claim 47 also claims a computer program product. In pg. 16, ¶44 of the specification the Applicant states the computer program product may be an electronic signal which is non-statutory subject matter.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 34-38, 40, 41 and 44-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Takizawa et al. U.S. Patent 5,859,515. Regarding claims 34 and 44-50, Takizawa discloses a data carrier or electronic carrier signal (3) with machine control parameters for reading into a multiaxis machine tool (2) (col. 9, lines 16-20) having a workpiece holder for receiving a workpiece, a tool, activatable mechanical axes for machining the workpiece or for positioning the workpiece and the tool in relation to each other, an open-loop and/or closed-loop control device for activating axes (col. 49, lines 15-24, position controller), and at least one virtual axis which can be parameterized as a guiding axis for other axes and then serves only for the synchronization of these other axes (col. 52, lines 42-54), characterized in that on the data carrier or the electronic carrier signal there is at least one data structure which has a data field which allows the parameterization of the virtual axis as a guiding axis for other axes, and the data carrier or the electronic carrier signal (3) activates the machine tool (2) (abstract) during the reading-in or after the reading-in by means of this data structure such that the other axes are synchronized in their positioning with the aid of the virtual guiding axis (col. 52, lines 42-54).

Regarding claim 35, Takizawa discloses the data carrier or electronic carrier signal (3) with machine control parameters according to claim 34 for reading into the multiaxis machine tool (2), characterized in that on the data carrier or the electronic carrier signal there is at least

one data structure which also allows the parameterization of a mechanical axis as a guiding axis for other axes (col. 17, lines 34-37).

Regarding claim 36, Takizawa discloses the data carrier or electronic carrier signal (3) with machine control parameters according to claim 34 for reading into the multiaxis machine tool (2) (abstract), characterized in that on the data carrier or the electronic carrier signal there is at least one data structure which is intended for receiving a definition of a function or relation for the formation of the virtual axis by the open-loop and/or closed-loop control device (col. 49, lines 15-24, position controller).

Regarding claim 37, Takizawa discloses the data carrier or electronic carrier signal (3) with machine control parameters according to claim 34 for reading into the multiaxis machine tool (2), characterized in that on the data carrier or the electronic carrier signal there is at least one data structure which is intended for receiving a definition of a function or relation for the activation of the respective mechanical axis by the open-loop and/or closed-loop control device (col. 49, lines 15-24).

Regarding claim 38, Takizawa discloses the data carrier or electronic carrier signal (3) with machine control parameters according to claim 37 for reading into the multiaxis machine tool (2), characterized in that the data structure has at least one data field for the identification of at least one predefined type of function or relation (col. 23 and 24, lines 60-11), preferably a type of polynomial function, a type of circular relation or a type of table of coordinates, which is used for the definition of the function or relation of the respective mechanical axis.

Regarding claim 40, Takizawa implicitly discloses the data carrier or electronic carrier signal (3) with machine control parameters according to claim 34 for reading into the multiaxis

machine tool (2), characterized in that on the data carrier or the electronic carrier signal there is at least one data structure which combines at least one group of machine control parameters corresponding to a partial region of the workpiece (col. 52, lines 42-54), as a segment under a common segment identification, preferably a segment number.

Regarding claim 41, Takizawa discloses the data carrier or electronic carrier signal (3) with machine control parameters according to claim 40 for reading into the multiaxis machine tool (2), characterized in that such a group of machine control parameters for which the same axis is parameterized as the guiding axis are always combined as a segment (col. 52, lines 42-54).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHARLES R. KASENGE whose telephone number is (571)272-3743. The examiner can normally be reached on Monday through Friday, 8:30 - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert DeCady can be reached on 571 272-3819. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CK

March 27, 2008

/Charles R Kasenge/

Primary Examiner, Art Unit 2121